

REMARKS

The present application was filed on January 23, 2002. In a Preliminary Amendment filed concurrent with the present application, Applicants canceled without prejudice claims 31-36 and 38-51. Thus, claims 1-30 and 37 remain pending with claims 1, 13, 21, 29 and 37 being the independent claims.

In the outstanding Office Action, the Examiner: (i) rejected claims 1-16, 20-30 and 37 under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,199,099 to Gershman et al. (hereinafter "Gershman"); (ii) rejected claims 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Gershman in view of U.S. Patent No. 6,182,124 to Lau et al. (hereinafter "Lau"); and (iii) rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Gershman in view of Lau and further in view of U.S. Patent Application No. 2001/0014868 to Herz (hereinafter "Herz").

In this response, Applicants amend independent claim 1 and traverse the various rejections of claims 1-30 and 37, for at least the following reasons.

With regard to the issue of whether claims 1-16, 20-30 and 37 are anticipated under 35 U.S.C. §102(e) by Gershman, the Office Action contends that Gershman discloses all of the claim limitations recited in the subject claims. Applicants respectfully assert that Gershman fails to teach or suggest all of the limitations in claims 1-16, 20-30 and 37, for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the rejection based on Gershman does not meet this basic legal requirement, as will be explained below.

The present invention, for example, as recited in amended independent claim 1, recites a method for use in a distributed data network wherein a user may request and receive content from one or more entities in the distributed data network, the method comprising the steps of providing one or more mechanisms for enabling at least one of the user and one or more of the entities to control which entities in the distributed data network have access to information generated in association with the user's activity on the distributed data network, wherein the user specifies at least one role and, based on the created role, at least one profile for the user is maintained by one or more of the entities in the form of information inserted into the profile by one or more of the entities, the information representing the user's activity on the distributed data network with respect to the one

or more entities that inserted the information, such that profile maintenance is substantially transparent to the user; and customizing content to be received by the user in accordance with at least a portion of the information in the user profile. The language added by this amendment is underlined above. Support for the amendment may be found throughout the present specification. By way of example only, see page 11, line 16, through page 12, line 9.

Thus, as now recited, the user specifies at least one role and, based on the created role, at least one profile for the user is maintained by one or more of the entities (e.g., merchants) in the form of information inserted into the profile by one or more of the entities. The information represents the user's activity on the distributed data network with respect to the one or more entities that inserted the information. Thus, profile maintenance is substantially transparent to the user.

In an illustrative embodiment described at page 11 through page 12 of the present specification, once the user creates a role (e.g., persona) via a personae server, he must trust the server to accurately enforce the privacy policies he specified. However, maintenance of the profile is maintained by the merchants inserting records (about user activity, e.g., user bought a book on Egypt may be entered by the bookstore) in a profile database (PDB), and is effectively transparent to the user.

On the other hand, in Gershman, a user profile is maintained by the user interacting with a "statistical agent" (see column 33) to create statistics that are stored in the profile for future merchant use. Thus, unlike the claimed invention, Gershman does not disclose profile maintenance which is maintained by the entity and thus transparent to the user.

Regarding independent claim 13, a method is recited for use in accordance with at least one server in a distributed data network wherein a user may request and receive content from one or more entities in the distributed data network, the method comprising the steps of: maintaining two or more user-specified policies respectively associated with two or more roles within which the user may perform activities on the distributed data network; and issuing access credentials associated with the user-specified policies to one or more entities that seek to access information generated in association with the user's activity on the distributed data network so as to customize content to be received by the user in accordance with at least a portion of the accessible information. Independent claim 29 recites similar limitations.

Not only does Gershman fail to disclose a server issuing access credentials associated with the user-specified policies to one or more entities that seek to access information generated in association with the user's activity on the distributed data network so as to customize content to be received by the user in accordance with at least a portion of the accessible information, as in the

claimed invention, but the Office Action fails to even mention such limitations of claims 13 and 29 in citing Gershman in its rejection. It seems the Office Action only addresses the limitations of independent claim 1, while ignoring the limitations of independent claims 13 and 29.

Regarding independent claim 21, a method is recited for use in accordance with one or more databases in a distributed data network wherein a user may request and receive content from one or more entities in the distributed data network, the method comprising the steps of: storing information that the one or more entities learn in association with the user conducting activities with the one or more entities; and enabling the one or more entities to specify which other entities are able to access the stored information so as to customize content to be received by the user in accordance with at least a portion of the accessible information. Independent claim 37 recites similar limitations.

Not only does Gershman fail to disclose a database enabling the one or more entities to specify which other entities are able to access the stored information so as to customize content to be received by the user in accordance with at least a portion of the accessible information, but the Office Action fails to even mention such limitations of claims 21 and 37 in citing Gershman in its rejection. It seems the Office Action only addresses the limitations of independent claim 1, while ignoring the limitations of independent claims 21 and 37.

The Office Action at page 8 does assert that Gershman discloses “access control” in accordance with Permissions 1370. However, what Gershman expressly states is that “[t]hese permissions dictate who has what access rights to that particular Profile Field’s information” (column 33, lines 4-5). Profile Fields are previously described in column 32, lines 59-60, as personal information records provided by a user when setting up a persona. This is clearly not the same as a server performing the step of issuing access credentials associated with the user-specified policies to one or more entities that seek to access information generated in association with the user’s activity on the distributed data network so as to customize content to be received by the user in accordance with at least a portion of the accessible information, as in claims 13 and 29, nor is it the same as a database enabling the one or more entities to specify which other entities (note here that claim refers to the entities and not the user) are able to access the stored information so as to customize content to be received by the user in accordance with at least a portion of the accessible information, as in claims 21 and 37.

For at least the above reasons, Applicants respectfully assert that independent claims 1, 13, 21, 29 and 37 are patentable over Gershman. Also, not only are dependent claims 2-12, 14-16, 20, 22-28 and 30 patentable over Gershman based on their respective dependence on independent claims 1, 13, 21 and 29, but also because such dependent claims recite patentable subject matter in their

own right.

By way of example only, with regard to claims 4 and 5, the Office Action at page 3 states that Gershman discloses “substantial unlinkability” of profiles. However, no where does Gershman mention “substantial unlinkability” of profiles, including the portion cited in the Office Action for support, namely, column 41, lines 5-50. At page 8, the Examiner asserts that because Gershman mentions the use of different profiles for a user, this automatically means that the profiles are “substantial unlinkability.” This conclusion is without reasonable basis. No where does Gershman mention “substantial unlinkability.” The use of different profiles in Gershman may serve a convenience purpose for a user, however, this does not translate to “substantial unlinkability.”

Regarding the §103(a) rejection of claims 17 and 18, Applicants respectfully assert that the Gershman/Lau combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth in M.P.E.P. §2143, three requirements must be met to establish a prima facie case of obviousness. First, the cited combination must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Third, there must be some suggestion or motivation to combine reference teachings. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that the Gershman/Lau combination fails to teach or suggest all of the limitations of the claims, for at least the reasons given above with respect to independent claim 13. For at least this reason, a prima facie case of obviousness has not been established.

Second, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Gershman and Lau. For at least this reason, a prima facie case of obviousness has not been established. Despite the assertion in the Office Action, Applicants do not believe that Gershman and Lau are combinable since it is not clear how one would combine them. There is no guidance provided in the Office Action.

Gershman discloses a mobile computing environment that accesses the Internet to obtain product information for a user utilizing a distributed communication network, wherein user profiles may be updated by watching user activities. Lau discloses a token-based deadline enforcement system for electronic document submission. It is completely unclear how one would modify the user profile information or the techniques of Gershman to include the token-based deadline enforcement system for electronic document submission of Lau in order to achieve the claimed invention.

Lastly, there is a clear lack of motivation to combine the references. For at least this reason,

a prima facie case of obviousness has not been established. Gershman is directed to a technique for providing product information to a user in a mobile computing environment wherein user profiles may be updated based on user activities, while Lau is directed to a token-based deadline enforcement system for electronic document submission. That is, the teachings in each reference are directed to completely different environments; one (Gershman) toward provision of product information to a user in a mobile computing environment, the other (Lau) toward a technique for enforcing electronic document submission. However, other than very general and conclusory statements in the Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344.

In the Office Action at page 5, the Examiner provides the following statement to prove motivation to combine Gershman and Lau, with emphasis supplied: “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because Lau’s teaching would have allowed Gershman’s to enforce time limits on electronic submission by revoking access privileges of the user at the time a deadline expires as suggested by Lau”

Applicants submit that this statement is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner again merely states mutually exclusive features of each reference: “access privileges” (presumably Gershman), and “time limits on electronic submission” (presumably Lau). However, such statements fail to identify any objective evidence of record which point out what would motivate one to combine these mutually exclusive features of Gershman and Lau. Also, Gershman has nothing whatsoever to do with electronic document submission.

A similar argument applies to the combination of Gershman and Lau to reject claim 18.

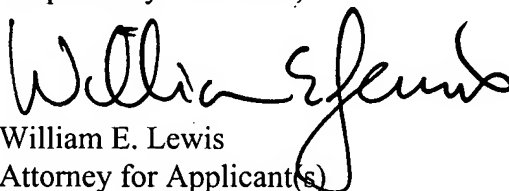
Accordingly, Applicants assert that independent claims 17 and 18 are patentable over the cited combination and therefore allowable.

Regarding the §103(a) rejections of claim 19, Applicants assert that Herz fails to remedy the

above-noted deficiencies of Gershman and Lau. Also, such claim recites patentable subject matter in its own right. Accordingly, Applicants assert that such claim is patentable over the cited combination and therefore allowable.

In view of the above, Applicants believe that claims 1-30 and 37 are in condition for allowance, and respectfully request withdrawal of the §102(e) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis", written over the typed name.

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